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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,007	11/02/2000	Shlomo Assa	LASER1140-2	4811

26161 7590 04/30/2003

FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

PHAM, HAI CHI

ART UNIT	PAPER NUMBER
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2861

DATE MAILED: 04/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Applicant(s)

09/705,007

ASSA ET AL.

Examiner

Hai C Pham

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 18 April 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: (See attached Response to Arguments).
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-36.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

ADVISORY ACTION

Response to Arguments

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In this case, the combined prior arts of Hasebe et al. (U.S. 6,061,081) and Woelki et al. (U.S. 5,329,090) each teaches a laser marking method for inscribing codes in the form of characters or graphic patterns on the surface of a product. Hasebe et al. teaches all the basic limitations of the claimed invention including inscribing code on a

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moving product, the code being formed of dots produced by exposure of a laser beam, generating a corrected data set indicating the position that each of the dots would occupy in accordance with the moving speed of the product so as to print the code according to the corrected data set. By carefully determining the individual scanning speed of the laser beam so that the marking operation can be achieved within the available target time, "a mark high in picture quality can be inscribed on the workpiece" as Hasebe et al. repeatedly indicates at different passages of the disclosure. On the other hand, Woelki et al. recognizes that marks formed by a plurality of single small spots would be difficult to read, and therefore proposes that "a cluster of such spots is placed on a surface of a wafer in a microgrid within a larger grid defining the characters to be written on the wafer" (col. 1, lines 28-32). Since both Hasebe et al. and Woelki et al. are from the same field of endeavor, the purposes disclosed by Woelki et al. would have been recognized in the pertinent art of Hasebe et al. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the device of Hasebe et al. with the teaching of Woelki et al. The motivation for the combination would have been to produce marks of high quality picture as well as of high readability as indicated by Woelki et al. at col. 1, lines 28-32.

On the other hand, Spratte et al. (U.S. 5,175,425) teaches a method for marking a semiconductor surface with code in which the character density is adjusted where it is needed to enable a reliable reading and decoding. Since both Hasebe et al. and Spratte et al. are from the same field of endeavor, the purposes disclosed by Spratte et al. would have been recognized in the pertinent art of Hasebe et al. Therefore, it would

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have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the device of Hasebe et al. with the teaching of Spratte et al. The motivation for the combination would have been to provide code symbols that can be distinguished with high reliability as indicated by Spratte et al. at col. 1, lines 48-60 and col. 2, lines 12-18.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai C Pham whose telephone number is (703) 308-1281. The examiner can normally be reached on T-F (8:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin R. Fuller can be reached on (703) 308-0079. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722, (703) 308-7724, (703) 308-7382, (703) 305-3431, (703) 305-3432 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



HAI PHAM
PRIMARY EXAMINER
April 29, 2003